

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

Claims 1-3 and 7-9 remain pending in the present application. No changes to the claims were made by this Response.

The reissue oath/declaration is indicated as being defective under 37 C.F.R. § 1.324 and M.P.E.P. § 1414 because there is no request to correct inventorship of the patent and no statement from the current named inventors agreeing to the change of inventorship. In addition, claims 1-3 and 7-9 stand rejected under 35 U.S.C. § 102(f) on the grounds that the applicant did not invent the claimed subject matter. Applicant respectfully submits that the reissue oath/declaration is not defective and traverses the rejection of the claims for the reasons presented below.

U.S. patent appln. no. 08/069,739 ("the '739 application"), which issued as U.S. patent no. 5,343,878 ("the '878 patent") and which is the patent currently sought to be reissued by the present application, included the following three inventors: Eugene N. Scarberry, Patrick M. Handke, and Mark H. Sanders. Shortly after the Notice of Allowance was mailed in the '739 application, it became apparent that the claims allowed in the '739 application were invented solely by Mark H. Sanders. The applicant then filed, on May 16, 1994, a document entitled, "Amendment Under Rule 312 And Petition Deleting Correctly Named Original Persons Who Are Not Inventors In The Allowed Claims (37 C.F.R. § 1.48(b))". A copy of this document is attached.

On June 14, 1994, the Patent Office issued a Form PTOL-271 indicating that the May 16, 1994 Amendment will be entered. A copy of this document is also attached. On this form the Examiner set forth the following comments in the Report portion:

"The inventorship in this application is changed to delete Eugene N. Scarberry and Patrick M. Handke, leaving Mark H. Sanders as sole inventor. This is in agreement with the "Explanation of Inventorship filed concurrently with this

divisional application. Accordingly, the amendment under 37 C.F.R. 1.312 has been entered."

Applicant submits that, based on this explanation, the '739 application should have issued with only Mark H. Sanders listed as the sole inventor. It appears that the Patent Office erred in including all three inventors on the face of the '878 patent. It should be clear, however, that the inventorship of the '838 patent is solely that of Mark H. Sanders, despite what was erroneously published on the face of the '838 patent.

In this present reissue application, the inventorship remains solely with Mark H. Sanders. That is, new claims 7-9, like original claims 1-3, are also the sole invention of Mark H. Sanders. Thus, there was no need to request a corrected inventorship in the present reissue application. Likewise, there was no need to include a statement from the currently named inventors agreeing to the change in inventorship of the '878 patent. Thus, there is no error in the Reissue Application Declaration due to its lack of these items.

It should be noted that the correction of inventorship that took place in the '739 application was done under 37 C.F.R. § 1.48(b). As such, there was no need to include a statement from the currently named inventors agreeing to the change of inventorship.

The rejection of claims 1-3 and 7-9 on the grounds that the applicant did not invent the claimed subject matter does not apply for the reasons noted above. Namely, Eugene N. Scarberry and Patrick M. Handke are not the inventors of these claims, as explained above. The sole inventor is Mark H. Sanders, as set forth in the reissue declaration. Thus, the application is the invention of the claimed subject matter.

For the reasons presented above, applicant respectfully submits that the reissue oath/declaration is not defective and that claims 1-3 and 7-9 were invented by the applicant. Accordingly, applicant respectfully requests that the above indication that the reissue oath/declaration is defective and the rejection of claim 1-3 and 7-9 be withdrawn

All objections and rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

Respectfully submitted,

By 

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Attached: 1) Amendment Under Rule 312 and Petition Deleting Correctly Named Original Persons Who are Not Inventors in the Allowed Claims" dated May 11, 1994; and
2) Form PTOL-271 dated July 14, 1994.

Note: The Commission is authorized to charge any fee required under 37 C.F.R. §§ 1.16 or 1.17 to deposit account no. 50-0558.



file

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE - PAPER NO. 7

Patent Application of)
E. N. Scarberry et al) Group 3302
)
Serial No. 08/069,739) Examiner L. Dvorak
)
Filed June 1, 1993)
)
For Pressure Application)
Method (as amended))
)

Pittsburgh, Pennsylvania
May 11, 1994

AMENDMENT UNDER RULE 312 AND PETITION DELETING
CORRECTLY NAMED ORIGINAL PERSONS WHO ARE NOT
INVENTORS IN THE ALLOWED (CLAIMS 37 CFR 1.48(b))

Hon. Commissioner of Patents
and Trademarks

Washington, D.C. 20231

Sir:

This amendment under Rule 312 and petition under 37 CFR 1.48(b) is filed for the purpose of removing from the application the names of Eugene N. Scarberry and Patrick M. Handke, originally named as inventors in the captioned application, whose invention is no longer being claimed in the application. Removal from the application of the names of the specified persons is respectfully requested.

The claims now on file in this application are claims 13 to 15.

This amendment and petition, together with the accompanying official fee, is being filed diligently upon cancellation of all claims to which the inventors whose names are being deleted made a contribution, namely claims 1 to 12, and 16 to 22, which were cancelled by the Examiner's amendment mailed February 28, 1994.

The inventorship of the claims now on file in application is as follows: Mark H. Sanders is the inventor of the subject matter of claims 13 to 15. At all times from conception of the earliest invention claimed in the application until the present, ownership of the subject matter of all claims now on file in the application has been vested in the assignee of record in the application.

This amendment and petition is accompanied by the official fee of \$130 as required by 37 CFR 1.17(h).

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Entry of the above amendment under provisions of
37 CFR 312 and granting of this petition under provisions of
37 CFR 1.48(b) is respectfully requested.

Respectfully submitted,


J. Stewart Brams,
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FIRST CLASS MAILING CERTIFICATION

I hereby certify that this correspondence is being
deposited with the United States Postal Service as First Class
Mail in an envelope addressed to: Commissioner of Patents and
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J. Stewart Brams



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Washington, D.C. 20231

08/069739 SERIAL NUMBER FILING DATE FIRST NAMED APPLICANT ATTORNEY DOCKET NO.
06/01/93 SCARBERRY E

DVORAK, L.

EXAMINER

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ART UNIT
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06/14/94

DATE MAILED:

A. The petition filed _____ under 37 CFR 1.312(b) is granted.
The paper has been forwarded to the examiner for consideration on the merits.

B. The amendment filed 5/16/94 under 37 CFR 1.312 has been
considered, and has been:

1. entered
2. entered as directed to matters of form not affecting the scope of the invention (0.3311).
3. disapproved. A report appears below.
4. entered in part. A report appears below.

Report: See attached explanation below.

The inventorship in this application is changed to delete Eugene N. Scarberry and Patrick M. Handke, leaving Mark H. Sanders as sole inventor. This is in agreement with the "Explanation of Inventorship" filed concurrently with this divisional application. Accordingly, the amendment under 37 CFR 1.312 has been entered.

Any inquiry concerning this communication should be directed to Linda Dvorak at telephone number (703) 308-0858.

RICHARD J. APLEY
SPE
ART UNIT 332

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